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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/675,123 | 09/30/2003 | Brent Dalmas Nelson | EDSC106US0 | 4963 |

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EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/675,123 | NELSON, BRENT DALMAS | |
| | Examiner | Art Unit | |
| | Nathan Hillery | 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/12/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 5/12/06.
2. Claims 1 – 19 are pending in the case. Claims 1, 10 and 18 are independent.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 – 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the terms “symbol type spreadsheet” and “symbol type mark-up language file”, which appear to be used interchangeably throughout the claims, have very little if any support in the specification. The only sentence in the detailed description that mentions these terms is *Metamodel generator process 146 opens metamodel specifications spreadsheets 152, runs a predetermined and herein described set of spreadsheet macro-programs to automatically batch generate all needed object type, relationship type, and symbol type XML files for the operation of processes within metamodel system 150* (part of paragraph block 0062). Based on this disclosure, it is the Office’s contention that one of ordinary skill in the art at the time of the invention would not have been enabled to make and/or use this invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 – 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Regarding claims 1, 10, and 18**, the metes and bounds of the term “symbol type” is unclear. Consequently, all subsequent recitations of these terms are also rejected. Further, these terms have been loosely interpreted in so far as can be understood in light of the specification for the rejection(s) under 35 USC 103(a).

8. **Regarding dependent claims 2 – 9, 11 – 17 and 19**, the claims are rejected for fully incorporating all the deficiencies of the base claim(s) from which they depend.

Response to Arguments

9. Applicant's arguments filed 5/12/06 regarding 35 USC 112 have been fully considered but they are not persuasive.

10. Applicant argues that “symbol type XML files” are enabled in the specification because the abstract indicates that “symbol type spreadsheet” corresponds to element 188 of Figure 11 (p 13, first two full paragraphs).

11. The Office disagrees.

12. Figure 11 shows a portion of code, which is an exemplary embodiment or specific type of “symbol type spreadsheet”. It should be noted that the skilled artisan has only a snippet of code to discern what a “symbol type spreadsheet” might be.

Consequently, the claimed "symbol type mark-up language spreadsheet" will be interpreted as an "oSymbolClip spreadsheet file" within the broadest, reasonable interpretation in light of the specification, since at best, applicant has support for this particular embodiment of "symbol type mark-up language spreadsheet" as shown in Figure 11.

13. Applicant argues that "symbol type mark-up language spreadsheet" is definite because one of ordinary skill in the art would recognize that the claimed symbol type mark-up language spreadsheet is a mark-up language spreadsheet containing metamodel symbol types (p 14, first paragraph).

14. The Office disagrees.

15. First, it should be noted that the Office asserts that one of ordinary skill in the art at the time of the invention would not have been well apprised as to the meaning of "metamodel symbol types". Second, it is still unclear without a clear and deliberate definition in the specification. It should also be noted that in response to all of the requests made in the requirement for information set forth by the Office in the previous action of 2/9/06 Applicant's representative states that the information required to be submitted is unknown to or is not readily available to the undersigned or the assignee of this application (pp 9 – 12).

16. As explained above, the "oSymbolClip spreadsheet file" partially shown in Figure 11 is the only example provided by the specification to describe a "symbol type mark-up language spreadsheet" and consequently will be used to interpret this spreadsheet.

17. Applicant's arguments see pp 16 & 17, filed 5/12/06, with respect to claims 1 – 19 have been fully considered and are persuasive. The rejections under 35 USC 103(a) of claims 1 – 19 has been withdrawn.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH


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